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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,085	10/21/2003	Toshiya Hagihara	1422-0609P	2826
2292	7590	12/23/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MARCHESCHI, MICHAEL A	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/689,085	Applicant(s) HAGIHARA ET AL. <i>mh</i>	
	Examiner Michael A Marcheschi	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1755

Claims 13 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 17 are indefinite as to the claimed limitations because the examiner is unclear as to what is being claimed. What are the members to be contacted? Although the claims define what they are made of, the claims fail to define what they are. In addition, the prior process claims do not define any member thus claims 13 and 17 lack antecedent basis with respect to this limitation.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3 and 7-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ina et al. for the same reasons set forth in the previous office action which are incorporated herein by reference. The limitations of new claims 7-9 are disclosed and/or encompassed by the reference. The content of the transition metals (Cu) defined by the reference reads on the claimed content.

Claims 1, 3 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Loncki et al. for the same reasons set forth in the previous office action which are incorporated herein by reference. The limitation of new claim 8 is disclosed and/or encompassed by the reference. The content of the transition metals (Cu) defined by the reference reads on the claimed content

Art Unit: 1755

Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as obvious over Loncki et al. for the same reasons set forth in the previous office action which are incorporated herein by reference. The limitation of new claim 7 is obvious because the reference uses about to define the content and as is well known "about" **permits some tolerance**, *In re Ayers*, 154 F 2d 182, 69 USPQ 109.

Claims 1, 3-6, 8, 11 and 15 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ohno et al. for the same reasons set forth in the previous office action which are incorporated herein by reference. The limitations of new claims 8, 11 and 15 are disclosed and/or encompassed by the reference. The content of the transition metals (Cu) defined by the reference reads on the claimed content. It is clearly disclosed in section [0001] that memory hard disks (magnetic disks) can be polished.

Claims 2, 7, 10, 13, 14 and 17 are rejected under 35 U.S.C. 103(a) as obvious over Ohno et al. for the same reasons set forth in the previous office action which are incorporated herein by reference. The limitations of new claims 7, 10 and 14 are obvious because the reference teaches an amount of abrasive and it is the examiners position that when this amount is converted to weight percent it will encompass the claimed range absent evidence to the contrary. The limitations of claims 13 and 17 are obvious because these limitations are an obvious modification therefore because this will avoid the introduction of unwanted impurities to the slurry. It is clearly disclosed in section [0001] that memory hard disks (magnetic disks) can be polished.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as obvious over GB 2,354,524 alone for the same reasons set forth in the previous office action which are incorporated herein by reference. The limitations of new claims 7, 10 and 14 (silica content) are clearly disclosed by the reference. The limitations of new claims 9, 12 and 16 (pH) are obvious because all compositions

Art Unit: 1755

must have a pH and the pH of polishing composition is dependent on the substrate to be polished. Since the same substrate is polished, it is the examiners position that the pH can be within the claimed range. In addition, it is the examiners position that since the reference fails to mention any specific pH (criticality), this (the absence of any such limitations) constitutes a broad teaching of pH values, as long as the final composition is obtained. In view of this, it can be reasonably interpreted that the claimed values are encompassed by the broad teachings according to this reference in the absence of any evidence showing the contrary (criticality). The limitations of new claims 8, 11 and 15 (copper content) are obvious because it is the examiners position that since the GB reference fails to mention this (criticality), it can be reasonably presumed and therefore obvious that the impurity level can be within the claimed values in the absence of any evidence showing the contrary. In addition, one skilled in the art would have found it obvious to produce a slurry having none or an extremely small impurity level in order to optimize the slurry polishing performance (i.e. impurities in the slurry will hinder the polishing performance because they will come into contact with the substrate which is not desired and diminish the polishing performance of the composition). Any limitation known to provide beneficial results to the claimed composition is well within the level of ordinary skill in the art. The limitations of new claims 13 and 17 are obvious because these limitations are an obvious modification therefore because this will avoid the introduction of unwanted impurities to the slurry.

Applicant's arguments filed 10/19/04 have been fully considered but they are not persuasive.

Applicants argue that Ina et al. and Loncki et al. do not teach a “magnetic disk substrate” polishing composition. The examiner acknowledges this but (1) *the preamble limitation “magnetic disk substrate” is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641 and (2) applicants are claiming a “composition” which the intended use does not carry any weight to the composition (see In re Thuau 57 USPQ 324 (CCPA 1942).* Any composition possesses a property such that it may be used for a purpose. In addition, irrespective of what the material is called, the composition is the same and thus no distinction is seen to exist. Applicants also appear to argue that the copper content in the references is not disclosed for the same effects as the present invention. Although this may be true, the examiner sees no distinction because the composition is the same irrespective of what the effects are.

Applicants argue that Ohno et al. does not teach a “magnetic disk substrate” polishing composition. Contrary to applicants position, it is clearly disclosed in section [0001] that memory hard disks (magnetic disks) can be polished. In the alternative and assuming arguendo, (1) *the preamble limitation “magnetic disk substrate” is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641 and (2) applicants are claiming a “composition” which the intended use does not carry any weight to the composition (see In re Thuau 57 USPQ 324 (CCPA 1942).* Any composition possesses a property such that it may be used for a purpose. In addition, irrespective of what the material is called, the composition is the same and thus no distinction is seen to exist. Applicants also appear to argue that the copper content in the reference is not disclosed for the same effects as the present invention. Although

Art Unit: 1755

this may be true, the examiner sees no distinction because the composition is the same irrespective of what the effects are.

Applicants argue that GB 2,354,524 uses a phosphate compound and the instant invention does not. Applicants use comprising which opens the claims to this component. Applicants fails to argue the obviousness observation of the cooper content as applied by the examiner in the last office action, thus no further comment is deemed necessary. The examiner fails to see any significant evidence of unexpected results for the claimed copper content and therefore, absent sufficient unexpected evidence, the claimed invention is obvious of this reference.

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1755

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

"A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)". In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

"A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)".

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

Art Unit: 1755

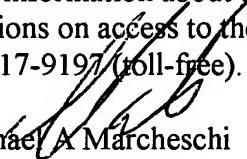
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/20/04

MM


Michael A Marcheschi
Primary Examiner
Art Unit 1755